

## **REMARKS**

This application has been reviewed in light of the Office Action mailed February 16, 2010. Reconsideration of this application in view of the below remarks is respectfully requested. By the present amendment, claims 1, 5 and 12 are amended; and new claims 20-25 are presented. Support for the amendment and new claims can be found at page 7, lines 9-11, page 7, line 22- page 9, line 3, page 10, lines 8-15, page 11, lines 15-22 and Figures 3A-3C, 4 and 5. No new subject matter is introduced into the disclosure by way of the present amendment. Claims 1 – 25 are pending in the application with claims 1, 5, and 12 being in independent form.

### **Rejection under 35 U.S.C. § 103 (a)**

Claims 1-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,238,336 issued to Ouchi (hereinafter “Ouchi”) in view of Japanese Publication No. JP 11-076254 (hereinafter, “Masatoshi”) and further in view of U.S. Patent No. 5,759,154 issued to Hoyns (hereinafter “Hoyns”). Claim 1 is amended to clarify that the cutting tip portion is formed by cutting the distal end side of the needle tube, reciting “having a cut surface intersecting with a circular surface of the needle tube.” It is clarified that the cut surface and the circular surface are different surfaces of the needle tube. Also, claim 1 is amended to clarify that reflection surface for displaying a needle-tube image is increased by providing the annular-shaped recesses, “having bottoms and sides which are regions to face a scanning face of an ultrasonic transducer included in the ultrasonic endoscope.”

Further, claim 1 is amended to recite “each of the annular-shaped recesses being non-partially formed and provided from a back surface of the cutting tip portion near a tip of the needle tube on which the cutting tip portion is formed.” (emphasis added).

Hoyns teaches recesses on a back surface of the cutting tip portion as can be seen at Figures 1 and 1A. The recesses around the edge (border) between the cutting surface 12 and the circular surface of the needle 10 have only a partial shape because of the cutting surface, i.e., part of the recesses' structure is missing. On the other hand, in the present invention, the entire recesses' structure is within the circular surface of the needle tube. Therefore, Hoyns does not teach the feature above as recited in claim 1.

Ouchi does not teach any recesses and Masatoshi does not teach recesses from a back surface of the cutting tip portion near a tip of the needle tube. Masatoshi's structure would cause a problem as explained in the specification as "in the event that the ultrasonic waves are cast onto the needle tube 30 from directions perpendicular to the longitudinal direction of the needle tube 30, or even in the event the ultrasonic waves are cast from directions other than the perpendicular directions, the ultrasonic waves are reflected with great intensity in the incident direction, and thus the images of the needle tube are clearly displayed in the ultrasonic observation images." (See, specification, page 3, lines 2-12). Therefore, neither Ouchi nor Masatoshi overcomes the deficiencies identified above with respect to Hoyns. Accordingly, for at least the reasons presented above, claim 1 and independent claims 5 and 12, which are similarly amended and the dependent claims are believed to be patentable over the cited prior art references. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to claims 1-19 under 35 U.S.C. § 103(a).

#### **New Claims**

New claims 20-25 are presented. Claims 20, 22 and 24 further distinguish from cited references, including feature of configuration of annular-shaped recesses. Claims 21, 23 and 25 further distinguish from cited references, including feature of the circumferential recess provided

in a full shape (non-partially) from a back surface of the cutting tip portion to a predetermined range on a surface of a tip portion, which is an area excluding the cut surface of the cutting tip portion. Therefore, these new claims are patentable for the additional reasons.

### CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, claims 1-19 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,

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